

## **REMARKS**

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

### **Summary of Office Action**

In the Office Action, beginning at page 2, Claim 12 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Office Action, beginning at page 3, Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Frey et al. Additionally, Claims 1-3 and 6-7 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tanaka. Beginning on page 4, Claims 1, 2 and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Dickinson.

In the Office Action, beginning at page 4, Claims 10-16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of Dickinson. Beginning on page 6, Claims 10-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of Tanaka et al. Finally, beginning on page 7, Claims 4-5 and 8-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka et al.

### **Summary of Response to Office Action**

In Response to the October 24, 2006 Office Action, Applicant hereby amends claims 1, 9, 10, 12, and 15, and cancels claims 4, 8, 13, and 19-43 without prejudice or disclaimer. New claims 44-50 are added. Accordingly, claims 1-3, 5-7, 9-12, 14-18 and 44-50 are currently pending. Claims 1, 10, and 44 are the only pending independent claims.

### **All Claims Are Allowable**

Claims 1-18 in this application are rejected under various provisions of U.S. law. Applicant respectfully submits that all claims are allowable for the specific reasons set forth

below, and therefore requests issuance of this application.

***35 U.S.C. § 112, second paragraph***

In the Office Action, beginning at page 2, claim 12 was rejected under 35 U.S.C. § 112, second paragraph, as reciting subject matter that is allegedly indefinite. Applicant respectfully traverses this rejection and requests reconsideration for at least the following reasons.

In the Office Action, the Examiner indicates that there is insufficient antecedent basis for the limitation of “the equipment” in the claim. Accordingly, claim 12 is hereby amended to remove the phrase “the equipment” thereby mooting the rejection. It is respectfully submitted that the changes to the claims are clerical in nature and do not narrow the scope of the claims.

For at least the foregoing reasons, Applicant respectfully submits that claim 12 fully complies with 35 U.S.C. § 112, second paragraph, and therefore respectfully requests withdrawal of the rejection thereof under 35 U.S.C. § 112.

***35 U.S.C. § 102(b)***

In the Office Action, beginning at page 3, Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Frey et al., Claims 1-3 and 6-7 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tanaka, and Claims 1, 2 and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Dickinson. Applicant respectfully traverses these rejections and requests reconsideration for the following reasons.

Frey discloses an inflatable insert for luggage. Tanaka discloses a buffer packing bag.

By contrast, claim 1 of the present application includes the feature of a bladder that includes a front side attached to a rear side by a hinge portion, and the bladder has a maximum height and maximum width of approximately 16 inches by approximately 22 inches when in the inflated state and configured for shipment, such that when the bladder is configured for shipment, it fits into the standard case supplied with a new flexible endoscope when the foam inserts are removed from the standard case.

At least this feature of claims 1-3, 6, 7 and 10 is neither taught nor suggested by Frey, Dickinson, or Tanaka.

It is a common patent law tenet that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). In this case, Dickinson, Frey and Tanaka fail to disclose at least the feature of a bladder that includes a front side attached to a rear side by a hinge portion, and the bladder has a maximum height and maximum width of approximately 16 inches by approximately 22 inches when in the inflated state and configured for shipment, such that when the bladder is configured for shipment, it fits into the standard case supplied with a new flexible endoscope when the foam inserts are removed from the standard case, as recited in claims 1-3, 6, 7 and 10. Since Frey, Dickinson and Tanaka fail to disclose each and every feature of claims 1-3, 6, 7 and 10, Frey, Dickinson or Tanaka fail to anticipate claims 1-3, 6 and 7. Withdrawal of all rejections of claims 1-3, 6, 7 and 10 under 35 U.S.C. § 102(b or e) be withdrawn.

**35 U.S.C. § 103(a)**

In the Office Action, beginning at page 4, claims 10-16 and 18 were rejected under 35 U.S.C. § 103(a) as reciting subject matter that is allegedly obvious, and therefore allegedly unpatentable, over the disclosure of Schumacher in view of the disclosure of Dickinson. In addition, Claims 10-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of Tanaka et al., and Claims 4, 5, 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka et al. These rejections are respectfully traversed, and Applicant requests reconsideration for at least the following reasons.

None of the above applied art references disclose or teach, either alone or in proposed combination, at least the feature of a bladder that includes a front side attached to a rear side by a hinge portion, and the bladder has a maximum height and maximum width of approximately 16 inches by approximately 22 inches when in the inflated state and configured for shipment, such that when the bladder is configured for shipment, it fits into the standard case supplied with a

new flexible endoscope when the foam inserts are removed from the standard case, as recited in claims 1-9, or the feature of a return pouch formed by at least one inflatable bladder and including a plurality of baffles, as recited in claims 10-18.

Because none of the applied art, either alone or in combination, teaches the above-referenced feature, as well as other features, of Applicant's claims 1 or 10, it is respectfully submitted that there is no *prima facie* case for obviousness.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any specific evidence of nonobviousness by Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In the present case, as stated above, neither of the cited references either alone or in combination teaches or suggests at least the feature of a bladder that includes a front side attached to a rear side by a hinge portion, and the bladder has a maximum height and maximum width of approximately 16 inches by approximately 22 inches when in the inflated state and configured for shipment, such that when the bladder is configured for shipment, it fits into the standard case supplied with a new flexible endoscope when the foam inserts are removed from the standard case, as recited in claims 1-9, or the feature of a return pouch formed by at least one inflatable bladder and including a plurality of baffles, as recited in claims 10-18. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claims 1 and 10.

The Office Action fails to meet all three requirements for establishing a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of claims 4, 5, 8, 9, and 10-18 under 35 U.S.C. § 103(a) be withdrawn.

#### **New Claims**

New claims 44-50 are added to provide an alternate scope of protection for the invention. It is respectfully submitted that these new claims are also in immediate form for allowance. Early and favorable examination of all claims is respectfully requested.

#### **Conclusion**

Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If the patent examiner believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, they are invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account listed on Applicant's initial patent application filing transmittal document.

Respectfully submitted,  
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